

REMARKS

In the Office Action issued on March 30, 2009, the Examiner:

- acknowledged the Request for Continued Examination filed on January 30, 2009;
- withdrew the finality of the previous Office action;
- Entered the After Final Amendment filed on January 6, 2009 as the submission with the Request for Continued Examination;
- rejected claims 1, 2, 4, 8, and 11 under 35 U.S.C. §102(a) as being anticipated by United States Patent No. 6,383,206 to Gillick *et al.* ("Gillick");
- rejected claim 12 under 35 U.S.C. §103(a) as being unpatentably obvious over Gillick in view of United States Patent Application Publication No. 20010039450 to Pavcnik ("Pavcnik").

The Applicants have fully considered the Office action and cited references and submit this Reply and Amendment in response to the Examiner's rejections. Reconsideration of the application for patent is requested.

Preliminary matter – Summary of Interview conducted on June 10, 2009

The undersigned attorney thanks the Examiner for the telephone interview held on June 10, 2009. During the interview, the undersigned attorney explained various potential amendments to the claims. While no agreement was reached,

the Examiner's input regarding the potential amendments was helpful and is appreciated.

Amendments to the Claims

Applicants have herein amended independent claim 1 to distinguish Gillick by clarifying that the ancillary delivery device is inserted into and advanced through the lumen of the elongate member to achieve the spacing of a portion of the elongate member from a wall surface of the body vessel.

The amendments to the claims are fully supported by the application as filed; no new matter has been introduced. Exemplary support is found in paragraphs [0037], [0041], and [0044], and in Figures 5 and 6 and the accompanying discussion.

Rejection of Claims 1, 2, 4, 8, and 11 under 35 U.S.C. §102

The Examiner rejected Claims 1, 2, 4, 8, and 11 under 35 U.S.C. §102(a) as being anticipated by Gillick. Specifically, the Examiner indicated that "*Gillick et al.* disclose a method for delivering and deploying an expandable intraluminal device" that includes the steps recited in the rejected claims of the present application for patent. (Office action, p. 2, bottom).

Gillick teaches a delivery system adapted to capture embolic material which may be created and released into the bloodstream during an interventional procedure. The system includes a filter 26 that is *attached to a shaft 30* and surrounded by a sheath 38 (see, *e.g.*, Figure 1). The filter 26 is expanded by removing the sheath 38 from a position around the filter 26 (see column 6, lines

32 through 37 and Figures 8 through 11, for example).

As amended herein, independent claim 1, from which all remaining claims depend, explicitly requires, *inter alia*, the following steps:

- **advancing the distal end of the elongate member over the guidewire and through the body vessel and to a desired point of treatment;**
- **removing the guidewire from the body vessel by retracting the guidewire through the lumen of the elongate member;**
- **inserting the ancillary delivery device into the proximal end of the elongate member and into the lumen;**
- **advancing the ancillary delivery device through the lumen until the means for spacing exits the distal end of the elongate member.**

Gillick does not teach such a method. Indeed, the Gillick device is not capable of operating in this manner because the filter 26 is attached to the shaft 30. As such, the filter 26 cannot be inserted into a lumen of the shaft after removal of a guidewire, nor can it be advanced through such a lumen until the means for spacing exits the distal end of the shaft.

A thorough review of Gillick reveals a complete absence of any teaching or suggestion of any of the steps listed above. As such, the reference does not anticipate Claim 1 or any of the related dependent claims. The Applicants respectfully request withdrawal of this rejection of the claims.

Rejection of Claim 12 under 35 U.S.C. §103

The Examiner rejected Claim 12 under 35 U.S.C. §103(a) as being

unpatentably obvious over Gillick in view of Pavcnik. Specifically, the Examiner indicated that "*Gillick et al.* disclose the claimed steps except for the expandable intraluminal medical device comprising a venous valve." (Office action, p. 4, bottom)

Claim 12 depends from Claim 1 and, therefore, includes all limitations of that claim. As described above, Claim 1 has been amended herein to include various limitations requiring, *inter alia*, that the ancillary delivery device be insertable into the lumen of the elongate member. As described above, Gillick does not teach or suggest the limitations added herein. Pavcnik fails to cure this defect of Gillick and, as such, the rejection does not present a *prima facie* case of obviousness because it fails to teach or suggest each and every limitation of the rejected claims.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claim 12 in light of the amendments made herein.

CONCLUSION

The Applicants have fully responded to the rejections listed by the Examiner in the March 30, 2009 Office action.

The Applicants maintain that a Notice of Allowability relating to all claims currently under consideration is appropriate and respectfully request that the Examiner issue such Notice upon entry of this Reply and Amendment.

Should the Examiner have any questions regarding this Reply and Amendment, or the remarks contained herein, the undersigned attorney would welcome the opportunity to discuss such matters with the Examiner.

Respectfully submitted,

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